UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,781	07/31/2000	Gregory J. Wolff	074451.P117	4872

7590 07/12/2006	**EXAMINER**
Michael J Mallie Blakely Sokoloff Taylor & Zafman LLP 12400 Wilshire Boulevard Seventh Floor Los Angeles, CA 90025-1026	BAUTISTA, XIOMARA L

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
		09/629,781	WOLFF ET AL.
Office Action Summary		Examiner	Art Unit
		X. L. Bautista	2179

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *26 April 2006*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3-29,31-36 and 44-47* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,3-29,31-36,44-47* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 4/26/2006, with respect to the rejections of claims

1, 3-24, 26-29, 31-36 and 44-47 have been fully considered but they are not

persuasive.

A.   Applicant argues, "Levy fails to disclose a network appliance to receive a

request to play a media object from a controller (e.g., a portable device or PDA) over

a wireless network...to determine whether the requested media object is stored in

the network appliance, to retrieve the requested media object from a server over a

second network different than the first network (e.g., wireless network), and to play

the retrieved media object within the network appliance (rather than the

controller), (page 10, third paragraph, lines 2-4).

In response, Levy discloses a method and system for transferring audio

objects (media object) over a computer network (wire or wireless network; col. 2,

lines 5-21; col. 4, lines 26-32); wherein the object is received in a player, tuner, or

capture device (PDAs, etc.; col. 4, lines 33-39; col. 14, lines15-24, 34-42). Levy

discloses retrieving the media objects from multiple servers (col. 4, lines 49-67; col.

5, lines 1-13, 66-67; col. 6, lines 1-2, 43-50). Levy discloses playing the media object

within the appliance (col. 6, lines 29-39; col. 14, lines 10-67).

B.   Applicant argues, "...there are at least three parties involved here: a

controller, a network appliance coupled to the controller over a first network, and a

server coupled to the network appliance over a second network different than the

first network, where the first network is a wireless network..." (page 10, last

paragraph).

In response, Levy discloses, and illustrates in figure 1, an embedding process,

registration process, database information, mapping process, and distribution

process (controller) for sending the media object to a decoding process (appliance),

and at least two servers, which may be in different networks, wherein the networks

may be wire and wireless networks.

C.   Applicant argues, "...if...the audio player...of Levy may be considered as a

network appliance...such an audio player does not receive a request to play a media

object from a controller over a wireless network...download the requested media

object from a server over a second network different than the first network...and

play the media object for the controller wirelessly communicating with an appliance

within Levy." (page 15, lines 1-6).

In response, see responses to arguments A and B. In addition, claim 1 recites

"a controller configured to select an identifier associated with a media object and to

send a request to play the media object identified by the identifier" (Levy shows in

figure 1 and discloses in col. 4, lines 20-67, the process of selecting an identifier

associated with a media object and sending the media object to an appliance so that

the media object can be played).

D.   Applicant argues, "the media object is not stored within the controller and

the controller only stores identifiers for identifying the media objects." (page 15,

second paragraph).

In response, Levy discloses a decoding process that forwards the extracted

identifier to a communication application, which forwards it in a message to a

server; and based on the identifier, the server determines an action to perform, such

as redirecting an identifier to another server, downloading content, etc. Levy

explains that the decoding process may be implemented as a separate program or

device, or integrated into a player, tuner, or some capture device, such as a PDA

(col. 4, lines 25-43; col. 14, lines 34-39).

E.   Applicant argues, "...both Dom and Morris are related to GUIs for

manipulating digital object, while Levy is related to embedding an identifier within

an audio stream for the commercial advertisement purposes. There is not

suggestion within Levy, Dom, and Morris to combine with each other." (page 15,

third and fourth paragraphs).

In response to applicant's argument that there is no suggestion to combine

the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so found

either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

Levy discloses a decoder for collecting identifiers in response to a user request while

media objects (e.g., music) are being played (col. 12, lines 37-67; col. 13, lines 1-28);

Dom is used in combination with Levy for its teaching of retrieving media objects

(e.g., video) from a first server via a second network; and Morris is used in

combination with Levy/Dom for its teaching of a group of all the thumbnail images

in storage, and a second group having thumbnail images selected from the first

group.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

3.   **Claims 1, 3-15, 21, 22, 24-29, 31-35, and 44-47 are rejected under 35 U.S.C.**

103(a) as being unpatentable over *Levy et al* (US 6,505,160 B1) and *Dom et al* (US

6,166,735).

Claims 1, 21, 29, 35 and 44:

Levy discloses a system and method for linking audio and other multimedia
data objects with metadata and actions via a communication network (computer,
broadcast, wireless, etc). Levy teaches that media objects are transformed into
active, connected objects via identifiers. Identifiers are extracted from the media
object and forwarded to a server; the server maps the identifier to an action or
re-directs the request to one or more other servers; the server may respond with an
option for the user to buy the link and control the resulting action for the object
with the identifier (col. 1, lines 27-58; col. 2, lines 15-23, 38-43, 53-61). Levy
discloses a system having a controller for selecting an identifier associated with a
media object and send a request to play the media object identified by an identifier;
the controller sends the request over a wireless communication media (network
access); an appliance for receiving the request having the identifier from the
controller, for retrieving the media object from a first server via a network
connection when the media object is not stored in the appliance, and for playing the
media object (col. 4, lines 20-67; col. 5, lines 1-12, 56-65; col. 6, lines 3-67; col. 7,
lines 1-12; col. 10, lines 4-29, 58-67; col. 12, lines 37-67; col. 13, lines 1-28).

Levy does not teach that the media object is retrieved from a first server via a
second network when the object is not stored in the appliance. However, Dom
discloses a system for browsing video data objects provided from a remote repository

over a network. Dom explains that the Internet facilitates access to information

resources by letting people jump from one server to another (col. 2, lines 14-39);

Dom teaches that the invention facilitates user browsing of video objects stored at

remote repositories such as a remote network server and downloading of the object

(col. 4, lines 58-63), and that the invention may be practiced in a system in which a

user operates a local computer system having a GUI for browsing a video object

stored in a separate or remote repository (col. 6, lines 66-67; col. 7, lines 1-2). Dom

explains that the invention covers systems residing entirely in a single, local site,

wherein the communications take place over direct local connections (col. 7, lines 5-

8), and that it also has applicability to remote networks (col. 7, lines 3-32). Dom

teaches that video objects may be retrieved from local or remote servers through

multiple networks (Internet, Intranet, WANs, LANs). Therefore, it would have

been obvious to one ordinarily skilled in the art at the time the invention was made

to modify Levy's media delivery system to include Dom's teaching of retrieving

media objects from servers at multiple networks because users are provided with an

interface that facilitates finding, retrieving and downloading desired media objects

that are stored at either local or remote repositories.

Claims 3-7 and 34:

See claim 1. Levy teaches synchronization to enable the first means to have

the identifiers associated with the media objects stored in the third means; first and

second servers for storing the media object; an appliance for retrieving the media

object from a second server when the media is not found in the first server (col. 3,

lines 24-48; col. 4, lines 40-60, 62-67; col. 5, lines 1-13; col. 6, lines 29-50).

Claims 8-10, 12 and 33:

Levy explains that a licensing server may be programmed to download

software players and new music offerings compatible with those players. The

licensing server may provide software for decrypting, decoding, and playing

electronically distributed music according to usage rules packaged with the

electronically distributed music. Levy teaches that the linking of the MP3 file

enables the content owner to market music and products that promote the sale of

audio objects in other formats, included formats protected with encryption (col. 6,

lines 29-59).

Claim 11:

See claim 8. Levy teaches that in the event that a media object is not linked,

the decoding and server processes can be programmed to enable the user to

purchase a link for the object (col. 1, lines 55-58; col. 2, lines 53-61; col. 3, lines 15-

21; col. 6, lines 60-67; col. 7, lines 1-12, 29-31).

Claims 13, 14 and 22:

See claim 1. Levy teaches identifiers but it does not teach that identifiers are

selected by selecting a visual representation of the media object. However, Dom

discloses a computer system for viewing and browsing video data objects provided

from a remote repository over a network such as the Internet (col. 1, lines 7-13; col.

2, lines 9-39, 49-63). Dom teaches identifiers selected by selecting a thumbnail

(video visual representation), (col. 5, lines 13-31, 66-67; col. 6, lines 1-9; col. 8, lines

12-20). Therefore, it would have been obvious to one ordinarily skilled in the art at

the time the invention was made to modify Levy to include thumbnail images for

representing media objects because they not only can be used to invoke other

functions but also provide the user with a general idea of what the image looks like

before selecting it; it can be used for quick identification; as an aid in indexing,

previewing and/or cataloging images; they facilitate downloading and reduce

download time.

Claim 15:

Dom shows a group of thumbnails in fig. 3 (col. 9, lines 25-29).

Claim 24:

Levy teaches electronic transactions and payment information (col. 2, lines

62-67; col. 3, lines 1-23; col. 13, lines 49-67).

Claim 25:

Levy teaches a decoder that can be implemented in a software or hardware

player, a tuner, etc. (col. 12, lines 37-41); a decoding device that communicates with

a hanheld device, which can be used for enabling a user to fetch information and

make orders from music as the music is playing (col. 12, lines 42-45, 51-53). Levy

teaches that the activation of the "fetch it" feature may be made on a handheld

device that communicates with the decoding device in a tuner via a wireless

connection (col. 12, lines 66-67; col. 13, lines 1-6). Levy explains that the features of

the invention may be implemented in one or more device (remote control device, and

a separate tuner with a decoder), or they may be integrated into a single device (col.

13, lines 23-28).

Claims 26 and 27:

Levy teaches capture devices. Levy explains that the decoding process may

be implemented in a variety of devices or software that process media objects.

These devices and software include programmable devices such as personal

computers, personal digital assistants, personal stereos, tuners, televisions, etc. (col.

4,lines 25-32; col. 14, lines 34-40).

Claim 28:

Levy teaches audio and video objects (col. 10, lines 4-17).

Claim 31:

See claim 1. Levy teaches that a server may redirect a request when the

object is not stored in it (col. 1, lines 41-55; col. 4, lines 40-67; col. 5, lines 1-12; col.

6, lines 43-51).

Claim 32:

Levy teaches access authorization and user ID for transactions (col. 2, lines

62-67; col. 3, lines 1-23; col. 13, lines 50-67; col. 14, lines 25-33).

Claim 45:

See claim 1. Levy teaches that a media objects and its identifier travel

through electronic distribution, such as network communication (Internet), but does

not teaches that the network includes a wide area network. However, Dom teaches

media object that can be selected for download (col. 6, lines 15-22; col. 8, lines 12-

20). Dom teaches various computing devices (nodes) coupled to various networks

including local area networks, wide area networks, etc. (col. 7, lines 22-32).

Claim 46:

See claim 1. Levy teaches a plurality of servers for retrieving identified

media object (fig. 1; col. 5, lines 54-65; col. 6, lines 29-58).

Claim 47:

See claim 1. Levy teaches media objects having a tag (key), both being stored

within the device (abstract; col. 4, lines 25-67; col. 5, lines 1-22). Levy teaches

downloading content (col. 4, lines 49-61) and format protection with encryption (col.

6, lines 43-58).

4.   **Claims 16-20, 23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Levy/Dom* and *Morris et al* (US 6,097,389).**

Claims 16, 23 and 36:

Levy/Dom does not teach a second group including selected thumbnail images from a first group including all the stored thumbnail images. However, Morris discloses a method and apparatus for providing a user interface for presenting a collection of digital media in a media container. Morris illustrates, in figs. 12B and 12F, two groups of thumbnails; the first group is in the thumbnail region 305 for displaying all the thumbnails 1265, and the second group is in the album page region 309 for displaying selected thumbnails 1261. Thus, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify Levy/Dom to include Morris's teaching of a first and second region for grouping thumbnails because they allow the user to create different collections of documents or media objects, which may be desirable in some cases.

Claims 17-19:

See claims 1 and 16. Levy teaches a playlist (col. 3, lines 24-48; col. 10, lines 58-67; col. 17, lines 4-8). Morris teaches a first subgroup including a list of thumbnails (media objects) and a second subgroup including one or more thumbnails (figs. 12B and 12F).

<u>Claim 20</u>:

Levy discloses a microphone to record audio annotations (col. 14, lines 34-67;

col. 15, lines 1-4). Morris teaches a text input area that enables users to enter

information associated with the thumbnails (figs. 8A and 9; col. 10, lines 11-67; col.

11, lines 1-45).

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Roman discloses a handheld device for video transmission

and display. Roman teaches a combined network where a plurality of nodes are

connected to a network comprised of both a wired network and a wireless network;

the nodes being enabled to transmit video to any of the other nodes, wherein any of

the nodes in the network could be a handheld video device (abstract; p. 1, par. 0011;

p. 3, par. 0036, 0042; p. 4, par. 0046-0050; p. 13, par. 0188-0196; figs. 19A-19C, and

20B).

6.   Applicant's amendment necessitated the new ground(s) of rejection presented

in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

7.   Any inquiry concerning this communication or earlier communications from

the examiner should be directed to X. L. Bautista whose telephone number is (571)

272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-
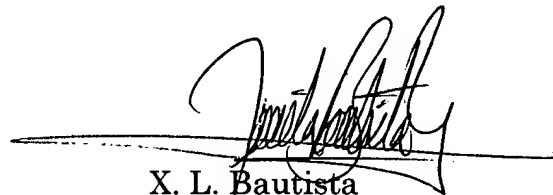
6:00PM.

        If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

8.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-

272-1000.

X. L. Bautista
Primary Examiner
Art Unit 2179

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July 3, 2006